

REMARKS

In the Office Action¹, the Examiner objected to the specification; rejected claims 1-8, 10-19, 21, 23-25, 28, 29, 31, and 33-35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,374,290 to Scharber et al. ("*Scharber*") in view of U.S. Patent No. 6,480,885 to Olivier ("*Olivier*"); and rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over *Scharber*, *Olivier*, and further in view of U.S. Patent No. 6,493,703 to Knight et al. ("*Knight*").

Applicant has amended claim 25 and 28. Claims 1-8, 10-19, 21-25, 28, 29, 31, and 33-35 remain pending.

I. Objection to the Specification

Regarding the objection to the specification, the Examiner states that there "is insufficient antecedent basis within the specification for the term 'computer-readable recording medium'" (Office Action at page 3). Applicant does not agree with the Examiner. Nonetheless, in an effort to advance prosecution, Applicant has amended claims 25 and 28 to remove "recording." Applicant submits that the specification at paragraphs 0047-0049, for example, provides support for the claimed "computer-readable medium." Therefore, Applicant requests that the Examiner withdraw the objection.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

II. Rejection of claims 1-8, 10-19, 21, 23-25, 28, 29, 31, and 33-35 under 35 U.S.C. §103(a)

Applicant respectfully traverses this rejection under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original). In this application, a *prima facie* case of obviousness has not been established because the Office Action has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious in view of the cited references.

Claims 1 recites a method including, for example:

providing access to one of the collaborative conversation channels through a user interface, with each one of the collaborative conversation channels having an associated set of message types that is based on a

topic of the specific one of the defined communities and a member's role within the specific one of the defined communities; [and]

receiving, through the user interface, a request to send a message having a selected message type within a selected one of the collaborative conversation channels, wherein the selected message type is selected at the user interface and the message is automatically filtered according to the selected message type and according to pre-configured filter profiles corresponding to the member's role within the specific one of the defined communities

(Emphasis added).

Scharber discloses “a method of information distribution including developing a plurality of virtual communities” (col. 2, lines 13-15). However, *Scharber* fails to teach or suggest a “member's role” within a community. Therefore, *Scharber* does not teach or suggest “each one of the collaborative conversation channels having an associated set of message types that is based on a topic of the specific one of the defined communities and a member's role within the specific one of the defined communities,” as recited in claim 1.

Olivier does not cure the deficiencies of *Scharber*. *Olivier* discloses “a method for users to exchange group electronic mail by establishing individual profiles” (col. 3, lines 9-10). According to *Olivier*, a user may visit a website and subscribe to a mailing list. The user may specify user profile data and acceptance criteria data (col. 5, lines 23-32). For example, a user may send a message to a school about the user's child. First, the user signs up for the school mailing list and specifies profile and criteria information, including location and geography of interest (col. 5, lines 54-56). Based on this information, the system in *Olivier* may calculate matches between the user and other people on the school mailing list (col. 5, lines 56-59). After the user sends an email, the

email server may receive the message and retrieve the user's information.

Based on the retrieved information, the email server sends the message only to those people that match the user's information (col. 5, lines 61-65).

However, *Olivier* still fails to teach or suggest "a member's role within the associated community." Even assuming that the school mailing list in *Olivier* could correspond to the claimed "defined communities," which Applicant does not concede, there is no teaching or suggestion in *Olivier* of a "member's role." *Olivier* merely discloses sending a message from a user to those people that match the user's information.

The Examiner states that Fig. 4 of *Olivier* discloses the claimed "topic of the specific one of the defined communities and a member's role within the specific one of the defined communities" (Office Action at page 2). This is not correct.

According to Fig. 4 of *Olivier*, a neighborhood mailing list exists. A user may select the appropriate profile data (ref. 402) and acceptance criteria data (ref. 406). The user may also select message acceptance criteria data (ref. 412). Even assuming that ref. 412 in *Olivier* could correspond to the claimed "associated set of message types," which Applicant does not concede, there is no teaching or suggestion in *Olivier* that exchanging email about news or recommendations is based on both 1) "a topic of the specific one of the defined communities," and 2) "a member's role within the specific one of the defined communities," as recited in claim 1.

On the contrary, email about news or recommendations is independent of any user profile data or acceptance criteria data. Accordingly, any “associated set of message types” that may exist in *Olivier* is not based on 1) “a topic of the specific one of the defined communities,” and 2) “a member’s role within the specific one of the defined communities,” as recited in claim 1.

The Examiner also cites to col. 14, line 55 - col. 15, line 21 of *Olivier*, and states that the moderator “is another version of a *member’s role within the specific one of the defined communities*” (Office Action at page 2) (emphasis in original). According to col. 14, line 55 - col. 15, line 21 of *Olivier*, a moderator may act “as a human filter for inappropriate messages, scanning for ‘spam’ and other messages that shouldn’t be sent to the subscribers.” However, filtering messages by a moderator does not teach or suggest that the types of messages that may be filtered are based on 1) “a topic of the specific one of the defined communities,” and 2) “a member’s role within the specific one of the defined communities,” as recited in claim 1.

The Examiner also cites to col. 25, lines 7-10 and 17-20 of *Olivier* to allegedly disclose “each one of the collaborative conversation channels having an associated set of message types that is based on a topic of the specific one of the defined communities and a member’s role within the specific one of the defined communities” (Office Action at page 3). This is not correct.

According to col. 25, lines 7-10 and 17-20 of *Olivier*, groups form around a theme, a user may select a group or club, and the user may specify acceptance criteria within the club. Based on this information the “user then only see content

. . . of other users who form a match with the user.” In addition, “authorities” may “view all messages, even if [th]ere is no mutual acceptance criteria data match.”

However, while “authorities” may view all content and users can view a subset of the content, this example in *Olivier* fails to teach or suggest that the types of messages are based on both 1) “a topic of the specific one of the defined communities,” and 2) “a member’s role within the specific one of the defined communities,” as recited in claim 1. Accordingly, *Olivier* also fails to teach or suggest “each one of the collaborative conversation channels having an associated set of message types that is based on a topic of the specific one of the defined communities and a member’s role within the specific one of the defined communities,” as recited in claim 1.

As outlined above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established.

Claim 1 is thus allowable for at least these reasons, and claims 2, 3, 6-8, 10, 12, and 13 are also allowable at least due to their depending from claim 1.

Independent claims 14, 25, and 29, while of a different scope, are allowable over *Scharber* and *Olivier* for reasons similar to that discussed above for claim 1. Claims 15-19, 21-24, 28, 31, and 33-35 are also allowable at least due to their dependence from independent claims 14, 25, or 29.

III. Rejection of claim 22 under 35 U.S.C. § 103(a)

Regarding the rejection of claim 22, which depends from independent claim 14, the Examiner relies on *Knight* for allegedly disclosing "a news reader existed that assigned icons for each news article" (Final Office Action at page 10). Even assuming this is correct, which Applicant does not concede, *Knight* still fails to cure the deficiencies of *Scharber* and *Olivier* discussed above. Therefore, claim 22 is also allowable over *Scharber*, *Olivier*, and *Knight* for at least the same reasons as claim 14.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 9, 2010

By: _____



C. Gregory Gramenopoulos
Reg. No. 36,532

Philip J. Hoffmann
Registration No. 46,340